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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,407	11/12/2003	George H. Forman	200300822-1	6790
22879 7590 06/04/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER LY, CHEYNE D	
			ART UNIT 2168	PAPER NUMBER
			MAIL DATE 06/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,407

Applicant(s)

FORMAN ET AL.

Examiner

Cheyne D. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 22, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8-17,28,30 and 37-46 is/are pending in the application.
- 4a) Of the above claim(s) 28,30 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-17 and 37-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3-5,8-17,28,30 and 37-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: dictionary.com (pages 1-2).

DETAILED ACTION

1. Applicants' arguments filed March 22, 2007 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

2. The cancellation of claims 2, 6, 7, 18-27, 29, 31-36, and addition of claims 37-46 have been entered.

3. Amended claims 28 and 30, and newly submitted claim 46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

4. For example, Group I, claims 1, 3-5, 8-17, and 37-45 are directed to a processor-based method for addressing an email message, classified in class 707, subclass 1. While, Group II, claims 28, 30, and 46, as amended, are directed to for sorting messages, classified in class 707, subclass 7. The distinct critical features of each Group support the undue search burden if they were examined together.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Joseph Swan (Reg. No. 41,338) on May 16, 2007 a provisional election was made without traverse to prosecute the invention of Group I, claims 1, 3-5, 8-17, and 37-45. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 28, 30, and 46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Claims 1, 3-5, 8-17, and 37-45 are examined on the merits.

RESPONSE TO ARGUMENTS

8. The 35 USC 101 rejection directed to claims 1, 3-5, 8-17 has been withdrawn as necessitated by claim amendments; therefore, Applicant's arguments directed to withdrawn claims are moot.

9. The prior art rejection of record has been withdrawn as necessitated by claim amendments. Further, Applicant has asserted that "claim 1 has been amended...by incorporating features of dependent claims 2, 6, and 7,...certain textual changes have been made to improve the organization of claim 1..." The assertion above and the amended claims support the instant claims are distinct from the claims previously examined because the amendments have change the scope of the claims.

10. The rejections discussed below have been necessitate by claim amendments.

CLAIM REJECTIONS - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 3-5, 8-11, 13, and 37-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson, A. (May 2001) (Anderson hereafter).

13. In regard to claim 1, Anderson discloses a processor-based method for addressing an email message (page 10, 4th paragraph, especially, “automated mailing list generation. The software described here creates e-mail distribution list”) the processor-based method comprising:

Defining at least one auxiliary criterion by accepting a signal from a user input device (page 26, Typical User section) to at least partially define the at least one auxiliary criterion, wherein the auxiliary criterion uses information in addition to information in an email address (page 29, last paragraph, especially, “allows user to request class rolls...”, to page 31, pages 32-33, especially, “Class Distribution List” and “Departmental Distribution List”);

Using the auxiliary criterion to identify a group of email addresses (page 29, last paragraph, especially, “allows user to request class rolls...”, to page 31, pages 32-33, especially, “Class Distribution List” and “Departmental Distribution List”); and

Sending the email message to the email addresses within the identified group (page 2, 2nd paragraph, “send messages to multiple recipients).

14. In regard to claims 3-5 and 13, Anderson describes the claimed invention as cited above.

15. In regard to claims 8-11, Anderson describes the group of email address is identified by a local processor to communicating with an external database remote from the local processor, wherein the auxiliary criterion is used by the local processor to access information in the external database (page 29, “Requesting Class Rolls” section, to page 30, “Receiving the Information section”).

16. In regard to claims 37 and 38, Anderson describes the signal from the user input device comprises a text string including a relational expression that defines the group (pages 32-33, especially, "Class Distribution List" and "Departmental Distribution List").

17. In regard to claims 39 and 40, Anderson describes the external database includes a human resource database and a facilities database (page 32 in its entirety). It is noted that page describes students database and departmental database which have been interpreted as the claimed database, as supported by the definitions of "human resource" and "facilities" by dictionary.com provide with the instant Office Action.

18. In regard to claim 41, Anderson describes the defining, using and sending steps are performed by an email client (page 38, "Using the Distribution Lists" section, especially, "e-mail client").

19. In regard to claims 42-45, Anderson describes the computer readable medium (page 10, 4th paragraph, especially, "automated mailing list generation. The software described here creates e-mail distribution list") for the above cited method.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent

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any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

22. Claims 12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, A. (May 2001) (Anderson hereafter) as applied to claims 1, 3-5, 8-11, 13, and 37-45 above, and further in view of Microsoft Press (1999).

MOTIVATION

23. Anderson describes an improvement to the Microsoft Outlook client to automate mailing list generation (page 10, 4th paragraph). Microsoft describes the well known in the art Outlook client for creating distribution lists (page 51, in its entirety). One of ordinary skill in the art at the time of the invention would have been motivated by Anderson to improve Outlook to automate mailing list generation.

PRIOR ART

24. In regard to claims 12 and 14-17, Anderson does not specify that the information being an identification of a manager's name, a company division, a project, an identification of a meeting, or a geographic location. Microsoft Press describes it is well known in the art that Outlook has been used to create distribution lists for any auxiliary criterion simply by naming the distribution list (page 51, in its entirety). Therefore, it would have been obvious to one of ordinary skill in the art to improve Outlook to include a variety of information such as an identification of a project, an identification of a meeting, or a geographic location to automate mailing list generation.

CONCLUSION

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

27. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The


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USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

28. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571) 272-3642.

C. Dune Ly 
Patent Examiner
5/29/07